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| APPLICATION NO. | FILING DATE                      | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|----------------------------------|----------------------|---------------------|------------------|
| 10/520,244      | 09/02/2005                       | Mark Diener          | 231945              | 2528             |
|                 | 7590 12/03/200<br>C & MAYER, LTD | EXAMINER             |                     |                  |
| TWO PRUDEN      | NTIAL PLAŽA, SUITI               | PETERSON, KENNETH E  |                     |                  |
| CHICAGO, IL     | TETSON AVENUE<br>60601-6731      |                      | ART UNIT            | PAPER NUMBER     |
|                 |                                  |                      | 3724                |                  |
|                 |                                  |                      |                     |                  |
|                 |                                  |                      | MAIL DATE           | DELIVERY MODE    |
|                 |                                  |                      | 12/03/2007          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|   | Application No.   | Applicant(s)   |  |  |
|---|---|--|--|--|
|   | 10/520,244  | DIENER, MARK   |  |  |
| Office Action Summary   | Examiner  | Art Unit   |  |  |
| _   | Kenneth E. Peterson   | 3724   |  |  |
| The MAILING DATE of this communication  |   | I  |  |  |
| Period for Reply  |   |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR RE WHICHEVER IS LONGER, FROM THE MAILING  - Extensions of time may be available under the provisions of 37 CFI after SIX (6) MONTHS from the mailing date of this communication  - If NO period for reply is specified above, the maximum statutory pe  - Failure to reply within the set or extended period for reply will, by s' Any reply received by the Office later than three months after the mearned patent term adjustment. See 37 CFR 1.704(b). | G DATE OF THIS COMMUNIC R 1.136(a). In no event, however, may a repl. ariod will apply and will expire SIX (6) MONT tatute, cause the application to become ABA | ATION. ply be timely filed THS from the mailing date of this communication. ANDONED (35 U.S.C. § 133). |  |  |
| Status  |   |  |  |  |
| 1)⊠ Responsive to communication(s) filed on 0   | 77 November 2007.   |  |  |  |
| 2a)⊠ This action is <b>FINAL</b> . 2b)□   | This action is <b>FINAL</b> . 2b) ☐ This action is non-final.   |  |  |  |
| 3) Since this application is in condition for allo  |   |  |  |  |
| closed in accordance with the practice und  | ler Ex parte Quayle, 1935 C.D.  | 11, 453 O.G. 213.  |  |  |
| Disposition of Claims   |   |  |  |  |
| 4)⊠ Claim(s) <u>20-56</u> is/are pending in the applic  | ation.  |  |  |  |
| 4a) Of the above claim(s) 21-29,32-36 and   | 39-56 is/are withdrawn from co  | onsideration.  |  |  |
| 5) Claim(s) is/are allowed.   |   |  |  |  |
| 6)⊠ Claim(s) <u>20,30,31,37 and 38</u> is/are rejected  | d.  |  |  |  |
| 7) Claim(s) is/are objected to.   | •   |  |  |  |
| 8) Claim(s) are subject to restriction ar   | nd/or election requirement.   |  |  |  |
| Application Papers  |   |  |  |  |
| 9)☐ The specification is objected to by the Exan  | niner.  |  |  |  |
| 10) The drawing(s) filed on is/are: a)  | accepted or b) objected to b  | y the Examiner.  |  |  |
| Applicant may not request that any objection to   | the drawing(s) be held in abeyand   | ce. See 37 CFR 1.85(a).  |  |  |
| Replacement drawing sheet(s) including the co   | rrection is required if the drawing(s   | s) is objected to. See 37 CFR 1.121(d).  |  |  |
| 11)☐ The oath or declaration is objected to by the  | e Examiner. Note the attached   | Office Action or form PTO-152.   |  |  |
| Priority under 35 U.S.C. § 119  |   |  |  |  |
| 12)⊠ Acknowledgment is made of a claim for fore   | eign priority under 35 U.S.C. §   | 119(a)-(d) or (f).   |  |  |
| a)⊠ All b)□ Some * c)□ None of:   |   |  |  |  |
| 1. Certified copies of the priority docum   | nents have been received.   |  |  |  |
| 2. Certified copies of the priority docum   | nents have been received in Ap  | plication No   |  |  |
| 3. Copies of the certified copies of the p  | priority documents have been r  | eceived in this National Stage   |  |  |
| application from the International Bu   | ` ' ' '   |  |  |  |
| * See the attached detailed Office action for a   | list of the certified copies not re   | eceived.   |  |  |
|   | **************************************  |  |  |  |
| Attachment(s)   |   |  |  |  |
| 1) Notice of References Cited (PTO-892)   | 4) Interview Su   |  |  |  |
| <ol> <li>Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>Information Disclosure Statement(s) (PTO/SB/08)</li> </ol>   | _   | /Mail Date<br>formal Patent Application  |  |  |
| Paper No(s)/Mail Date   | 6) Other:   | <u>-</u>   |  |  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. Claims 20,30,31,37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0722814 to Schultz et al., who shows a band saw with all of the recited limitations including;

A support device (6),

A machine frame (11,floor),

A main carrier (13),

A swivel support (D) having a driving device (14 or 16),

An intermediate carrier (15) having two vertical arms (9) with linear guides,

A saw frame (8) having two rollers.

A bandsaw blade (23) "configured for cutting metal". The blade is not *optimized* for cutting metal, but it is certainly *capable* of cutting metal (e.g. aluminum foil). Since it is *capable* of cutting metal, it is considered to be "configured for cutting metal".

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 20,30,31,37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0722814 to Schultz et al. in view of DE4040470 to Meba.

As set forth above, Schultz shows a saw with all of the recited limitations. If one was to interpret that Schultz's blade was not "configured for cutting metal", then Examiner takes Official Notice that it is well known for band saws to cut metal. An example of this is the patent to Meba. Additional examples can be provided if needed. It would have been obvious to one of ordinary skill in the art to have modified Schultz by employing Meba's blade on his machine, in order to better cut metal workpieces. Conversely, Meba's cutting machine could be modified to have Schultz's degrees of freedom, in order to give the operator more flexibility when cutting the workpiece.

- 5. Applicant's arguments have been fully considered but they are not persuasive.

  Applicant argues that one of ordinary skill would never consider modifying a stone cutting saw to cut metal instead. This argument is found to be completely unpersuasive. The courts have recently acknowledged that developments in parallel fields can be used as teachings.
- 6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

